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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/729,798	12/05/2003	Roy Hirst	MS305474.01/MSFTP1150US	2266
27195 7590 06/27/2007 AMIN. TUROCY & CALVIN, LLP 24TH FLOOR, NATIONAL CITY CENTER 1900 EAST NINTH STREET CLEVELAND, OH 44114			EXAMINER MEDE, ESTEVE	
			ART UNIT 2137	PAPER NUMBER
			MAIL DATE 06/27/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/729,798	Applicant(s) HIRST, ROY	
	Examiner Esteve Mede	Art Unit 2137	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>10/04/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claim 11-23, are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 11, discloses a document configured to enable tracking comprising a unique identifier, digitally encoded material associate with the unique identifier, and one or more built-in functions coupled to the digitally encoded material, the built-in function to govern transform and rendering of digitally encoded material. For a claim to be statutory it must be a process, machine, manufacture or composition of matter. The claim as read can be considered by one of ordinary skill in the art as a document per se, and therefore does not appear to be a process, machine, manufacturer, or composition of matter.

Dependent claims 12-15 are rejected; as they are also contain non-statutory subject matter.

Claim 16, discloses a computer readable medium computer-executable instructions to perform acts for storing digitally encoded material, the acts comprising associating a unique identifier with the digitally encoded material and associating one or more built-in functions with the digitally encoded material such that the unique and the built-in functions are coupled to the digitally encoded material, the built-in functions govern the transform and rendering of digitally encoded material. For a claim to be

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statutory it must have a useful, concrete and tangible result. The claim as specified in the specification on paragraph 16, lines 19-23 include an intangible medium such as carrier wave. While a carrier wave is a real entity, it is not tangible in the same sense that a floppy diskette would be considered tangible, because it is an ephemeral pattern imposed upon intangible energy.

Dependent claims 17-23 are rejected; as they are also contain non-statutory subject matter

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-23 are rejected under 35 U.S.C. 102(e) as being anticipated by Levy et al. (2002/0186844 A1).

Regarding claims 1, 11 and 16, Levy discloses a method of storing digitally encoded material, the method comprising; associating a unique identifier (para. 0009, lines 9-12) with digitally encoded material (para. 0006, lines 1-16); and associating one or more built-in functions with digitally encoded material such that the unique identifier and the built-in functions are coupled to the digitally encoded material, the built-in

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function are coupled to the digitally encoded material (the prior does not use the wording of built-in function, however the prior art uses wording such as usage rights, license or usage rules to define the built-in function of which the applicant is referring to (para. 11, lines 1-16).

Regarding claims 2 and 17, Levy discloses the method further comprising; associating a history of the digitally encoded material with the digitally encoded material (the limitation of associating a history with the digitally encoded material is implicitly disclosed in the prior art as the prior art is monitoring and tracking the how many times the content is used (para. 0044, lines 1-10).

Regarding claims 3, 18 and 23, Levy discloses the method further comprising; associating a history of the digitally encoded material, the wherein the history being located in a database (para. 0065, lines 1-7).

Regarding claims 4 and 19, Levy discloses the method wherein the built-in function includes one or more of Copy or Paste and Print (para. 0011, lines 14-16).

Regarding claims 5, 12 and 20, Levy discloses the method wherein the associating the built-in functions with the digitally encoded material enables the digitally encoded material to be stored in RAM in an encrypted form (para. 0070, lines 1-10).

Regarding claim 6 and 21, Levy discloses a method for tracking digitally encoded material, the method comprising appending a unique identifier to the digitally encoded material (para. 0065, lines 2-5; para. 0025, lines 10-12); encrypting a combination including the digitally encoded material and the unique identifier (para. 0025, lines 8-11); and appending built-in function source code and the encrypted combination to form

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an executable entity capable of being executed independent of an particular operating system (para. 0025, lines 1-8).

Regarding claim 7, Levy discloses the method wherein the built-in functions include one or more of copy paste and print (para. 0025, lines 4-7).

Regarding claims 8 and 13, levy discloses the method wherein the built-in functions include rendering functions and transform functions (para. 0026, lines 1-7).

Regarding claims 9 and 14, Levy discloses the method wherein the rendering functions include one or more of a close, find shape, full screen, go to guide, help, open, order pan, properties, reveal, rotate/flip, search, select, size, and position, spell check and zoom (para. 0026, lines 1-7; para. 0051).

Regarding claims 10 and 15, levy discloses the method wherein the transform function include one or more of copy, DRM agent, encrypt/decrypt, export, insert, log, new, paste, print, replace, save as (para. 0026, lines 1-7; para. 0011-12).

Regarding claim 22, Levy discloses the computer read-able wherein the acts further comprises, tracking the digitally encoded material by maintaining an auditable document history log (the limitation of an auditable document history log is implicitly stated by the prior art, as the an identifier is used to track content usage, therefore the tracking of the content would have to log, so that it may be tracked (see abstract).

Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Esteve Mede whose telephone number is 571-270-

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1594. The examiner can normally be reached on Monday thru Friday, 8:30-5:00 PM, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel Moise can be reached on 571-272-3865. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Esteve Mede
em
June 6, 2007


EMMANUEL L. MOISE
SUPERVISORY PATENT EXAMINER